

REMARKS/ARGUMENTS

Claims 38-47 are pending.

Claims 38-43 were examined and rejected.

The claims are not amended. The Applicants request reconsideration of this application in view of the remarks set forth below.

Rejections withdrawn

The Applicants acknowledge and appreciate the Examiner's decision to withdraw all prior rejections.

This Office Action should be a non-final Office Action

The Applicants request that the Examiner reconsider the finality of this Office Action. This request is accompanied by a Petition to the Director under 37 CFR § 1.181.

MPEP §706.07(a) states that a second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. §1.97(c).

The Office Action dated January 5, 2007, sets forth four new grounds of rejections under 35 U.S.C. § 102(e) and is indicated as being final.

On page 6 of the Office Action, the Examiner states that the Office Action is final because: "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action."

The Applicants acknowledge that the claims were amended in their prior response, but disagree that the amendment triggered the new grounds of rejection.

The Applicants submit that the new grounds of rejection were not triggered by the amendment because the "new" art is relied upon to provide disclosure claim elements that are present in both the amended claims *and* the claims before they were amended. Given this fact, there is no reason why the new rejections could not have been made in the previous Office Action.

In view of the foregoing discussion, the Applicants submit that the new grounds of rejection were not *necessitated* by an amendment to the claims.

Since the new grounds of rejection were not *necessitated* by an amendment to the claims, pursuant to §706.07(a), this Office Action is improperly indicated as a final Office Action.

In view of the foregoing discussion, the Applicants request that the Examiner withdraw the finality of the Office Action dated January 5, 2007.

Rejection of claims under 35 U.S.C. § 102

Claims 38-40 and 42 are rejected under 35 U.S.C. 102(e) as being allegedly anticipated by any or all of the following references: *Christenson* (US20030190739), *Daly* (US20020037582), *Geron Corp.* (US 6,599,728) or *Berthelson* (US 6,455,290). The Applicants respectfully traverse this rejection.

Each of the cited references is discussed below.

Geron Corp.

Geron Corp. is a U.S. patent that is a continuation of international patent application serial no. PCT/US00/09558, filed on April 10, 2000, which claims the benefit of two earlier filed U.S. provisional applications.

In summary, and in accordance with MPEP §2136.03.II, the applicable “§102(e) date” of *Geron Corp.* (i.e., effective date of *Geron Corp.* as a reference under 35 U.S.C. §102(e)) is the actual filing date of the application (i.e., October 5, 2001). Since October 5, 2001, is well *after* the applicant’s priority date (October 25, 1999), *Geron Corp.* is not available as prior art, and thus can not anticipate the Applicant’s claims. This rejection should thus be withdrawn.

In more detail, *Geron Corp.* is a patent that resulted from a continuation of an international patent application that was filed *prior to* November 29, 2000. As such, and in accordance with MPEP §2136.03.II¹, *Geron Corp.* is applied under the provisions of 35 U.S.C. §102 *prior to* amendment of this

¹ See MPEP §2136.03.II (with emphasis added in bold):

If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(A) If the international application meets the following three conditions:

- (1) an international filing date on or after November 29, 2000;
- (2) designated the United States; and
- (3) published under PCT Article 21(2) in English.....

If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

(1) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application;

statute under the American Inventors Protection Act of 1999 (the AIPA).

According to MPEP §2136.03.II, the effective date of *Geron Corp.* as a reference under §102(e) is “the earlier of the date of completion of the requirements of 35 U.S.C. § 371(c)(1), (2) and (4) *or* the filing date of the later-filed U.S. application that claimed the benefit of the international application.” Applicants could find no evidence that the *Geron Corp.* application, or the PCT application to which the *Geron Corp.* claims priority, completed the requirements of 35 U.S.C. § 371(c)(1), (2) and (4)² at date earlier than the October 5, 2001 filing date. The Applicants thus submit that the “§102(e) date” of *Geron Corp.* is its actual filing date of October 5, 2001.

Since October 5, 2001, is well *after* the applicant’s priority date (October 25, 1999), *Geron Corp.* is not available as art to the instant application, and thus cannot anticipate the Applicant’s claims under 35 U.S.C. §102(e).

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Daly

Daly fails to disclose a composition containing a source of ADP-ribose and, as such, fails to disclose the subject matter of the rejected claims.

As such, Daly cannot anticipate the rejected claims, and this rejection may be withdrawn.

Christenson and Berthelson

Claims 27-30, and 38-43 are rejected as being anticipated under 35 U.S.C. §102(e) by Berthelson, having an effective filing date of July 9, 1999, and Christensen, having an effective filing date of June 29, 1999.

(2) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b);

(3) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

² The Applicants have searched, but cannot find any evidence that PCT/US00/09558 completed the requirements of 35 U.S.C. § 371(c)(1), (2) and (4).

As set out in 37 C.F.R. §1.131:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§1.42, 1.43, or 1.47, ***may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference*** or activity on which the rejection is based. . . .

(b) ***The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.*** Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

(emphasis added)

The Applicants submit that the claimed subject matter was conceived prior to June 29, 1999 (Christensen's filing date: the *earlier* effective filing date of Berthelson and Christiansen), and diligently reduced to practice from the period between June 29, 1999 and October 25, 1999, the filing date of a parent of the instant application.

In order to establish that the claimed invention was conceived prior to June 29, 1999, and diligently reduced to practice from the period between June 29, 1999 and October 25, 1999, the Applicants direct the Examiner's attention to the Declaration under 37 C.F.R. §1.131 (the "Hitoshi Declaration") that was filed in the immediate parent of the instant application (09/843,159, now U.S. patent 6,887,675). A copy of the Hitoshi Declaration is re-submitted herewith for the Examiner's convenience.

The Applicants respectfully submit that Dr. Hitoshi's declaration and attached exhibits demonstrate conception of the claimed subject matter prior to the effective filing date of Berthelson and Christiansen, and diligent reduction to practice between June 29, 1999, and October 25, 1999.

Given the above, the Applicants submit that neither Berthelson nor Christiansen can preclude the patentability of the instant claims.

The Applicants submit that these rejections have been adequately addressed by the foregoing discussion. Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103

Claims 41 and 43-44 are rejected under 35 U.S.C. 103 as being unpatentable over *Christenson*, *Daly*, *Geron Corp.* or *Berthelson* in view of *Smith*. The Applicants respectfully traverse this rejection.

As discussed in the prior section of this response, none of the *Christenson*, *Geron Corp.* or *Berthelson* references is properly citable as prior art against the instant claims. As such, the rejection of claims over *Christenson*, *Geron Corp.* or *Berthelson*, in view of *Smith* may be withdrawn.

With respect to *Daly*, the Applicants submit that *Smith* fails to meet *Daly*'s deficiency (the source of ADP-ribose) and, as such, *Daly* and *Smith*, taken in any combination, fail to teach or suggest all of the elements of the rejected claims.

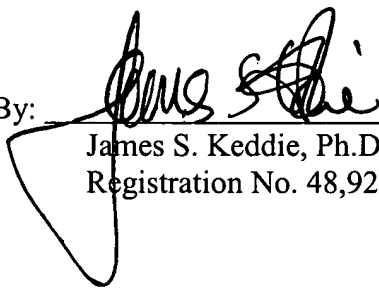
The Applicants submit that these rejections have been adequately addressed. Withdrawal of these rejections is respectfully requested.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-010CIP3.

Respectfully submitted,
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By: _____


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